



Paper No. 4

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OFFICE OF PETITIONS
A/C PATENTSIn re Application of
Talja, et. al.
Application No. 09/737,765
Filed: December 18, 2000
Attorney Docket No. 2880/323:
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: DECISION ON PETITION
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This is a decision on the petition filed March 29, 2001, requesting that the above-identified application be amended to include two sheets of drawings containing Figures 19, 20, 21 and 22.

The application was filed on December 18, 2000. However, on January 29, 2001, the Office mailed a "Notice of Omitted Items" stating that the application had been accorded a filing date of December 18, 2000, and advising applicants that Figures 19, 20, 21, and 22 described in the specification appeared to have been omitted.

In response, the present petition was filed requesting, in effect, that the application be amended to include the drawings containing Figures 19, 20, 21 and 22 described in the specification.

The petition is **DISMISSED**.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioners neither assert that the missing drawings were deposited on December 18, 2000, nor request the March 29, 2001 (the date the drawings were supplied) filing date.

Instead, applicants seek to amend the application to include the drawings. However, no petition under 37 CFR 1.182 is necessary

for that purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, the petition is inappropriate and is subject to dismissal.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 08/304,082 and specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawings containing Figures 19, 20, 21 and 22 are not new matter if they were a part of the disclosure of the prior application.

Since the present petition was not necessitated by any error on the part of the Office, the \$130.00 petition fee will not be refunded.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 18, 2000, including an indication in Office records that 11 sheets of drawings were present on filing.

Thereafter, the application will be forwarded to the appropriate group art unit for consideration by the examiner of the petition filed March 29, 2001, as an amendment requesting the entry of two new sheets of drawings.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Nancy Johnson at 703-305-0309.



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